

REMARKS

The Examiner has rejected claims 1-18 under 35 U.S.C. 112, first paragraph, as lacking enablement. However, it is urged that claims 1-18 are supported by an adequate enabling disclosure and the grounds of rejection do not follow established law.

First, for purposes of clarity, Applicants have amended claim 1 to now include the option of "a combination of an adjuvant and an herbicide", in addition to the options of an herbicide, a pesticide, and a fertilizer. Page 1, line 27 of the specification defines adjuvants as being materials that enhance the action of herbicides. This amendment therefore more clearly shows that the adjuvant is intended to accompany the herbicide. Support for the amendment itself may be found in the originally filed specification on page 10, lines 10-13, and in the abstract.

Next, it should be noted that the Examiner has previously determined that claims 1 and 10 were allowable, in the Office Action mailed October 3, 2005. Applicants therefore submit that the Examiner must have therefore considered these claims, in and of themselves, as being sufficiently enabling for one of ordinary skill in the art to make and use the invention as claimed, without undue experimentation.

Furthermore, Applicants urge that the Examiner's enablement arguments are not even remotely relevant to the present claims 10-18. The Examiner's present arguments are based on the agricultural actives described in the present claim 1 by the words "fertilizer", "adjuvant", "herbicide" and "pesticide". Applicants wish to point out that claims 10-18 require the presence of ammonium sulfate, a known adjuvant, in their suspensions. Thus, the Examiner's arguments relating to "all agricultural actives" does not apply to these claims, which all require this specific adjuvant. It is therefore urged that the rejections of claims 10-18 are improper and should be withdrawn.

Regarding the enablement issue, Applicants respectfully assert that claims 1-18 are sufficiently enabling such that one of ordinary skill in the art could make and use the invention as claimed. The enablement requirement of 35 U.S.C. 112 is discussed in MPEP § 2164. As described in MPEP § 2164.01, the standard for testing the enablement of a claim was established by the U.S. Supreme Court in the case of *Mineral Separation v. Hyde*. According to the court, a claim must be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). It is respectfully asserted that no undue experimentation is necessary to make and use the invention as described in claims 1-18.

Claim 1, as presently amended, provides a stable agricultural solids suspension readily dispersible in water, the suspension comprising:

- a. agricultural solids consisting essentially of at least one member selected from the group consisting of a fertilizer, a combination of an adjuvant and a herbicide, a herbicide, and a pesticide, said agricultural solids having particles more than about 99 wt.% passable through a Tyler #48 sieve;
- b. a single non-ionic surfactant selected from the group consisting of alkyl-phenoxy-poly(ethylenoxide)alkanols, ethoxylated aliphatic C₁₁ to C₁₅ alcohols, ethylene oxide-propylene oxide block copolymers and ethoxylated fatty acids;
- c. a water-soluble glycol liquid consisting of at least one member of the group consisting of ethylene glycol, and propylene glycol; and
- d. methylthio- α -hydroxybutyric acid.

The Examiner asserts that this claim is non-enabling, and takes the position that it is “unbelievable on its face” that “all agricultural actives”, such as claim 1’s listing of fertilizers, adjuvants, herbicides, and pesticides of component (a), would possess

chemical and physical properties that would allow for the production of a stable solid suspension once combined with the components of (b), (c), and (d). However, the Examiner has provided no prior art and no factual basis for his assertions. Furthermore, "In order to make a rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention." *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). The Examiner must provide a reasonable explanation as to why the scope of protection provide by a claim is not adequately enabled by the disclosure. It is respectfully submitted that the Examiner has not met this initial burden. Applicants urge that the claimed groupings of fertilizers, adjuvants, herbicides and pesticides are each generically useful components of the presently claimed suspensions. The principal inquiry to be undertaken when examining the question of whether the enablement requirement has been satisfied is whether the scope of enablement provided by the application is commensurate with the scope of the invention set forth in the claims. See, e.g., *In re Cescon*, 474 F.2d 1331, 177 USPQ 265 (CCPA 1973). The USPTO has historically considered it necessary to provide a broad scope of enablement by providing specific embodiments of the invention falling within the scope of the claims. In the case of *In re Robins*, 429 F.2d 452, 166 USPQ 552 (CCPA 1970) the court held that the mere listing of specific compounds, chemical substituents, solvents, cross-linking agents, etc. in the specification would in most cases provide evidence of enablement equivalent to that previously required in the nature of specific working examples using each of the various components. See *In re Stephens*, 529 F.2d 1343, 188 USPQ 659 (CCPA 1976). Applicants submit that the listing of specific materials and their purposes in the specification, including herbicides, adjuvants, fertilizers, and pesticides are described in such a way that one of ordinary skill in the art would readily ascertain how to make and use the claimed suspensions without undue experimentation.

Furthermore, it should be noted that the present claims relate only the *stable agricultural solids suspensions* which are formed from the disclosed components, and not to any materials which might hypothetically fail to qualify as stable solid suspensions. Thus,

any material which the Examiner envisions as failing to allow for the production of a stable solid suspension *would not* fall within the scope of useful agricultural solids according to the present invention.

It is submitted that no factual assertions *whatsoever* have been made by the Examiner to show that any of the claimed agricultural solids materials would be unsatisfactory in the formation of the claimed suspensions. Accordingly, Applicants hereby call on the Examiner to provide an affidavit under 37 C.F.R. 1.04(d)(2), attesting to any facts to his knowledge which were relied upon in his concluding that the present claims lack enablement. It should be noted that, by regulation, such an affidavit *must* be provided when called on by Applicant. Mere arguments are not sufficient in response to an Applicant's request for an affidavit under 37 C.F.R. 1.04(d)(2).

The CCPA has held that the disclosure of invention set forth by an applicant in his application must be given the presumption of correctness and operativeness by the PTO and that the only relevant concern of the PTO under the circumstances should concern the truth of the assertions contained in the application.

As a matter of Patent Office practice, then, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of S112 unless there is reason to doubt the objective truth of the statement contained therein which must be relied on for enabling support ... In any event, it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure. In re Marzocchi, 439 F.2d 220, 169 USPQ 367 (CCPA 1967). See also in re Bowen, 492 F.2d 859, 181 USPQ 48 (CCPA 1974).

The PTO Board of Appeals has adopted the standard established by the CCPA in Marzocchi. See, e.g., Ex parte Laiderman, 175 USPQ 757 (POBA 1971) and Ex parte

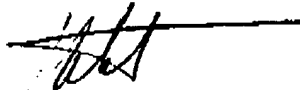
Kenage, 190 USPQ 346 (POBA 1976). Thus, as a matter of law, it must be believed that Applicant's disclosure is enabling. The Examiner has not provided a factual showing to prove otherwise.

It is respectfully asserted that one skilled in the art would be entirely capable of making and using the claimed suspensions with no undue experimentation being required. "As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied." MPEP § 2164.01(b). See also *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) (the scope of enablement must only bear a "reasonable correlation" to the scope of the claims). It is submitted that the present Examples *clearly* provide sufficient enablement for making the suspensions of the present claims.

For the foregoing reasons, it is respectfully urged that the rejections of claims 1-18 under 35 U.S.C. 112, first paragraph, should be withdrawn.

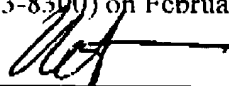
The undersigned respectfully requests re-examination of this application and believes it is now in condition for allowance. Such action is requested. If the examiner believes there is any matter which prevents allowance of the present application, it is requested that the undersigned be contacted to arrange for an interview which may expedite prosecution.

Respectfully submitted,



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I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office (FAX No. (571) 273-8300) on February 7, 2007.



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